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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,612	04/02/2004	Kia Silverbrook	HYC002US	9418
24011	7590	06/06/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/815,612	Applicant(s) SILVERBROOK ET AL.	
	Examiner Daniel A. Hess	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36, 39-42 and 45 is/are rejected.
- 7) ☒ Claim(s) 37, 38, 43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to 4/2/2004 filing by applicant.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Australia in 1999 and 2003. It is noted, however, that applicant has not filed a certified copy of the Australian applications as required by 35 U.S.C. 119(b).

Information Disclosure Statement

The information disclosure statement filed 10/7/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. In particular, the journal article by Dymetman was not included; nor was an indication given of where to find it. Thus, it was not considered.

Claim Objections

Claims 14-16, 27-29, 32-34 and 36-45 all have the following problem:

All 19 of these claims recite ‘... method according to claim x ...’ when claim x is not a method claim but a product claim.

Appropriate correction is required. This correction must convey the various limitations of the dependent claims that are stated as methods such that they are product limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-36, 39-42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al. (US 6,330,976) in view of Lieberman (US 5,855,369).

Re claims 1, 2, 8: Portions of the claim text are in italics followed in each instance by a discussion of the portions of the prior art which teach the claimed limitations.

*1. A product label for enabling entry to a competition, the product label comprising:
machine-readable coded data indicative of at least an identity of the label, said machine-readable coded data being readable by a sensing device as the sensing device is moved across the product label, thereby to produce interaction data for enabling the competition entry;*

Dymetman et al. teaches (see notably figures 8, 14 and 15) a system whereby a physical document (see figures 14 and 15) contains machine readable data which is readable by a sensing device (see figure 8). Dymetman et al. collects information on the identity of a page (pid) and location on the document through an optical scan of the surface of the document by sensing device. A (<pid, loc>) pair is derived from the coded data in a cell: see figure 5a, and conveys this pageid/location pair over a network (figure 9). Use of the system is suggested with a digital page (column 23, lines 30-50). The pageid corresponds to an identity of the label.

Dymetman fails to teach that the label is a product label for enabling entry to a competition. Lieberman remedies this, as will be discussed below.

human-readable information pertaining to the competition, the human-readable information being at least partially coincident with the machine-readable coded data,

As Dymetman shows (column 12, lines 59-67), “FIG. 4 illustrates components of a document printed on a coded substrate. Printed document 102 comprises layer 104 of printed visible (human-readable) information, i.e. document content, printed on coded substrate 106, illustratively a segment of a map though layer 104 could include text, photographic images, or any other human-readable information. The coded substrate 106 in turn comprises a layer 108 of visible or invisible machine-readable marking sprinted on a sheet medium 110 (e.g. paper).”

the human-readable

information including at least one field element that has a corresponding zone defined in relation to it in a page description stored in a remote computer system.

Dymetman et al. teaches (column 3, lines 57-61) :

“If the area of the marking medium is a page, the action/medium identifier can include a page identifier, and the action device can include digital data defining a counterpart image of the page. The counterpart image can be isomorphic with the page.”

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Thus Dymetman et al. refers to 'digital data defining a counterpart image of the page' which is indeed a page description that is stored on a remote computer system.

Dymetman et al. fails to teach or fairly suggest that his system is applied to a 'product label for enabling entry into a competition.'

Lieberman teaches, "According to the present invention, **prize drawing game of chance entry forms** are prepared which are imprinted with a **laser-scannable bar code** that uniquely identifies the **particular product** to be promoted. The entry forms are distributed to potential customers for that product, who are invited to complete the entry forms ... Once the completed entry forms are deposited and collected, the bar codes they bear are laser-scanned"(column 3, lines 15-40).

The document can be considered a product label, which can be defined as "An item used to identify something or someone" (American Heritage Dictionary).

In view of Lieberman's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Dymetman et al.'s technology to the prize drawing entry form product labels of Lieberman because this enables the data associated with the form to be gathered more quickly than would be possible if the forms were entered by hand. Note that Dymetman et al.'s system is able to collect writing and form entries etc. that are entered on a document (column 30, line 65 to column 31, line 40).

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Re claim 3: Dymetman et al. teaches: (column 9, lines 10-15):

“The user can click a button (not shown) on pointer 502, providing a signal similar to a mouse click, while the camera on the pointer is capturing an image of machine-readable markings either at a certain location on a physical page of document 2...”

Re claim 4: As described re claim 1 above, text can be entered in a document in Dymetman et al.

Re claim 5: As is clear throughout, text entered by the pen of Dymetman et al. is distinguished by gathering pen movements using coded data underlying the area where the writing takes place.

Re claim 6: Signature authentication (column 17, line 30) is included with Dymetman et al.

Re claim 7: Drawing (column 31, lines 5-20) can be received and processed in Dymetman et al.

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Re claim 9: As Dymetman et al. makes clear throughout, it is the coded data that leads the pen to gather data on positions and movements that can be used to discern, for example written words.

Re claims 10, 11: Dymetman et al. teaches, as has been discussed, gathering a generalized 'page identifier.' Applying Dymetman's technology to the contest of Lieberman, this page identifier would be the product identifier.

Re claim 12: If a product identifier is stored on a computer, it may be considered an 'electronic product code.'

Re claim 13: The coding markings can be (column 3, line 55) invisible.

Re claims 14, 15: Dymetman et al. enables forms and other paper entry data to be written on a printed document such that the various interactions as well as page identifier is picked up by the sensing device with the coded data enabling entry data to be passed to the computer system.

As combined with Lieberman, this entry data would be competition entry data and the receiver would clearly be a competition administrator.

Re claim 16: See discussion of writing (column 31). Pick-up of movement data is clearly shown.

Re claim 17: See discussions re claims 1 and 14 above.

Re claim 18: See discussion re claim 16, above.

Re claim 19: See discussion re claim 1, above.

Re claim 20: See discussion re claim 3, above.

Re claims 21-23: See discussion re claims 10-12, above.

Re claims 24-26: See discussion re claim 1, above.

Re claims 27-29: See discussion re claims 10-12, above.

Re claim 30: See discussion re claim 1, above.

Re claim 31: See discussion re claim 5, above.

Re claims 32-34: See discussion re claims 10-12, above.

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Re claim 35: See column 9, lines 1-5 of Dymetman, et al. One option made available is the ability to display various data on a display as a result of the user's interactions with the sensing device.

Re claim 36: See discussion re claim 14, above.

Re claims 39, 40: See discussion re claim 14, above. Also note that Dymetman et al.'s system is *intended* to be interactive, such that there are return responses that come back to the user from the administrator or application server.

Re claim 41: See discussion re claim 14 above. Naturally, the administrator of the competition in Lieberman as applied to Dymetman et al. is configured to pick winners. Who else would perform this role? That is the definition of competition administrator.

Re claim 42: See discussion re claim 14 above. Also note that Lieberman's contest can be associated with coupons (column 4, lines 15-25). The process of redeeming these coupons would be a natural step in this process.

Re claim 45: See discussion re claim 14 above. Also note that in the combination of Dymetman et al. and Lieberman, validating the competition entry would be a generally necessary step.

Allowable Subject Matter

Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The examiner could not find a method that involves a use of an anonymous competition alias id to be used in the claimed context of all of the other limitations recited, enabling anonymous entry into the competition.

Claims 38, 43 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Each of the above methods recites a series of specific steps **in the context of the various other recited limitations** to further enable competition entry using the interactive system of claim 1 including such steps as assigning of temporary telecommunications addresses, enabling a predetermined combination of coupon offers, and registration including a return electronic address. Dymetman et al. doesn't discuss competitions at all, and in Lieberman, the automated and data-exchanging portion of the competition is limitation mainly to the product id.

The examiner notes that the limitations of the above objected-to claims taken without the various other limitations upon which the claim depends would not necessarily be allowable.

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The examiner also notes that the issue of claim objections due to confusion between method and apparatus claims pointed out at the beginning of the instant action must be corrected.

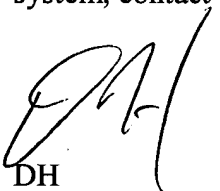
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wolff et al. (US 6,081,261) and several others shows an interactive pen that can be used with paper forms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DH
5/24/2005

DANIEL STCYR
PRIMARY EXAMINER
